

Applicant: Roger Dahl
Serial No. 10/082,967
Page 6

REMARKS

In the Office Action of February 25, 2005 the Examiner stated that "applicant appears to be confusing physical contact with electrical contact. When a defibrillation pulse is applied across the right and left atria, electrical contact is made with substantially all of the tissues of the right and left atria including, among other structures, the interior wall of the oblique vein." Rather than argue the shortcomings of this line of reasoning, Applicant previously amended the claims to eliminate the "apparent confusion" and deleted the term "electrical."

Claim 1, for example is a method claim that currently reads in relevant part "placing a first electrode into contact with a first portion of the heart, wherein the first portion of the heart is proximate a superior vena cava;

placing a second electrode into contact with a second portion of the heart, wherein the second portion of the heart is an interior wall of an oblique vein; and

transmitting an electrical pulse between the first electrode and the second electrode in response to a determination that a cardiac event is detected."

In the Advisory Action, the Examiner denied entry of the amendment, indicated new issues were raised and stated "the claims are now broader since 'contact' can be interpreted as not only physical contact by electrical contact. Because 'contact' can be interpreted to include electrical contact, the rejection stands." Applicant traverses and takes issue with several points.

1. No new issues raised.

Since the Examiner is apparently interpreting the claims on the record after amendment the same as prior to amendment, the notion that further search and consideration is required due to "new issues" does not appear to be correct and is therefore an improper basis to deny entry and consideration of the previous response.

Applicant: Roger Dahl
Serial No. 10/082,967
Page 7

2. Issue raised by Examiner

The "apparent" confusion raised by electrical contact versus other types of contact was an issue raised by the Examiner. Thus, Applicant's addressing of this "issue" "should reasonably have been expected" by the Examiner. MPEP 706.07(a). Thus, consideration After Final is appropriate.

3. Claims are allowable over art of record

The disclosed invention is unambiguous. Electrodes are disposed at specific anatomical locations as described and illustrated in the specification. Referring again to claim 1, as illustrative, a first electrode is placed into contact with a first anatomical location. A second electrode is placed into contact with a second anatomical location. A third step of transmitting a pulse is also defined. The notion that "contact" includes "electrical contact" (as defined by the Examiner – clearly the claimed electrode is in electrical contact with the tissue at the site of placement) is not supportable in view of the claims in context and when considered as a whole. For the Examiner's interpretation to hold, "placing" an act of physically positioning is being ignored and substituted by "transmitting" as (in the Examiner's interpretation) the electrodes are only in contact (electrically) when a waveform is transmitted. In other words, none of the claimed steps are performed absent generation of a pulse. In claim 1, a pulse is transmitted in response to a detected cardiac event. Thus, utilizing the referenced systems (a lead placed anywhere electrically contacts everything, according to the Examiner) the first and second electrode are not "placed" into "contact" until a cardiac event is detected, because only then is a pulse transmitted and only then is "electrical contact" established. This is clearly not a fair reading of the claims.

Thus, reading the claim as a whole and in context, along with the deletion of the term "electrical", the clear teachings of the specification, and Applicant's statements herein, the Examiner's rejection is unsupportable. Any person of

Applicant: Roger Dahl
Serial No. 10/082,967
Page 8

ordinary skill in the art recognizes that the electrodes are "placed" prior to detection and defibrillation. The claim language states that an electrode is placed into contact with an anatomical location. It does not state that the electrode is placed in some other physical location to define an electrical path through the anatomical location. Applicant respectfully requests reconsideration and withdrawal of the rejections of record.

Applicant's previous remarks are re-presented below:

Claims 1, 3-12 and 14-20 were rejected under 35 USC § 102(b) as being anticipated by Min et al., (U.S. Patent No. 5,690,686). Claims 1, 3-4, 7-8, 11, 14 and 17-18 were rejected under 35 USC § 102(e) as being anticipated by Kroll, (U.S. Patent No. 6,456,876). Claims 5-6, 9-10, 15-16 and 19-20 stands rejected under 35 USC § 103(a) as being unpatentable over Kroll, (U.S. Patent No. 6,456,876) in view of Min et al., (U.S. Patent No. 5,690,686). Applicant respectfully traverses these rejections.

The Examiner states that the claims have been interpreted such that "electrical contact" does not require the disposition of the lead in the anatomical locations previously argued by Applicant as one distinguishing feature. As such, the term "electrical" has been removed, as essentially suggested by the Examiner. Thus, various electrodes are placed into contact with various anatomical structures as claimed.

Though this is an amendment after final, Applicant respectfully asserts entry is proper as the amendments made "should reasonably have been expected" by the Examiner. MPEP 706.07(a). The claims are in condition for allowance.

Applicant's previous remarks are presented again:

The claims as amended more clearly indicate that a defibrillation shock is directed across the atrium from a high atrial position, such as proximate the superior vena

Applicant: Roger Dahl
Serial No. 10/082,967
Page 9

cava (SVC) to the oblique vein. This particular pathway provides for an effective defibrillation of the atria.

None of the references teach or suggest placing a defibrillation lead in the oblique vein. The Examiner appears to generalize the coronary sinus with the oblique vein. These are not synonymous anatomical structures. The oblique vein, along with the other cardiac veins drain into the coronary sinus. There is a rudimentary valve at the bifurcation of the oblique vein and the coronary sinus making access and navigation particularly difficult. The references of record introduce a lead through the coronary sinus and into the great vein or great cardiac vein; not the oblique vein.

As stated, this location is extremely difficult to access, requires navigable leads consistent with the present teachings, and provides for a unique and beneficial atrial defibrillation therapy. As such, the references of record fail to neither anticipate the pending claims nor render them obvious in combination. Applicant respectfully asserts that the claims are in condition for allowance and requests notice of the same. Should any issues remain outstanding, the Examiner is requested to telephone the undersigned attorney to attend to these matters.

Respectfully submitted,

Date: 5/16/05



Daniel G. Chapik

Reg. 43,424

Telephone: (763) 514-3066

Customer No. 27581